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In re Application of	:	
ISHIYAMA et al.	:	DECISION ON
Application No.: 09/913,722	:	PAPERS UNDER 37 CFR 1.42
PCT No.: PCT/US00/04001	:	
Int. Filing Date: 17 February 2000	:	
Priority Date: 18 February 1999	:	
Attorney Docket No.: 2554-9	:	
For: NOVEL AMIDE DERIVATIVES AS	:	
GROWTH HORMONE	:	

This a response to "Submission of Proof of Legal Representative under 37 CFR 1.42" filed 17 December 2001 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 17 February 2000, applicants filed international application PCT/US00/04001, which claimed a priority date of 18 February 1999. A proper Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 18 August 2001.

On 17 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee and a preliminary amendment.

On 15 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 17 December 2001, applicant filed "Submission of Proof of Legal Representative under 37 CFR 1.42" which included a declaration and power of attorney executed by nine joint inventors and Linda Joyce Maki on behalf of deceased inventor Gilda H. Loew.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

The declaration submitted on 17 December 2001 was executed by Linda Joyce Maki as "legal representative" to the deceased inventor Gilda H. Loew. Counsel avers that, "[i]nventor Gilda H. Loew is deceased. The inventors' declaration under Rule 63 is executed by her legal representative Linda Joyce Maki . . ." Therefore, the declaration submitted on 17 December 2001 appears to have been executed by the proper party under 37 CFR 1.42. However, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(b)(2), the declaration must also provide residence, citizenship, and post office address for the legal representative. The declaration filed on 17 December 2001 provides this information with respect to the deceased inventor, but not the legal representative. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is REFUSED.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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